



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jia-He LI Expected Examiner: P. Killos
Serial No.: TBA Expected Group Art 1625
Unit:
Filed: August 28, 2003 Docket: 70003.0002USD1
Title: SYMMETRICALLY DISUBSTITUTED AROMATIC COMPOUNDS AND
PHARMACEUTICAL COMPOSITIONS FOR INHIBITING POLY(ADP-RIBOSE)
GLYCOHYDROLASE, AND METHODS FOR THEIR USE

TRANSMITTAL SHEET

Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet (in duplicate)
- ☒ Request for Divisional Application Under 37 C.F.R. §1.53(b)
- ☒ The application is as follows: 68 pages of specification, 118 claims, 1 page of abstract, 0 sheets of drawings, and Oath or declaration from parent application (4 pages).
- ☒ Copy of Determination of Patent Term Adjustment under 35 U.S.C. 154(b) from parent application
- ☒ Copy of Recorded Assignment from parent application
- ☒ Return postcard

The Commission is authorized to charge Deposit Account No. 13-2725 in the amount of \$375.00 (basic filing fee (utility - small entity)). A duplicate of this sheet is enclosed for this purpose. The Commissioner is hereby authorized to charge any additional fees as set forth in 37 CFR §§ 1.16 to 1.18 which may be required by this paper or credit any overpayment to Account No. 13-2725.

Date: 8/29/03

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(PTO TRANSMITTAL - GENERAL)

Application No.: 10/649,951



Docket No.: 22227-00003-US2
(PATENT)

IPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Jia-He LI et al.

Application No.: 10/649,951

Confirmation No.: 6259

Filed: August 28, 2003

Art Unit: 1625

For: SYMMETRICALLY DISUBSTITUTED
AROMATIC COMPOUNDS AND
PHARMACEUTICAL COMPOSITIONS FOR
INHIBITING POLY (ADP-RIBOSE)
GLYCOHYDROLASE, AND METHODS FOR
THEIR USE

Examiner: H. M. Reyes

**RESPONSE TO RESTRICTION REQUIREMENT
AND PRELIMINARY AMENDMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Restriction Requirement issued on July 21, 2004, applicants would like to respond as noted below and submit a Preliminary Amendment. The undersigned is appreciative of the telephone conversation with the Examiner concerning the Restriction Requirement.

Applicants initially wish to point out that the instant Preliminary Amendment is subsequent to the instructions provided in our August 23, 2003 Transmittal papers, wherein the Office was instructed to cancel claims 1-46 and 61-118, while "Claims 47-60 are pending." In a similar fashion, the specification was amended to include a statement that the current application

is a divisional of application no. 09/829,827. See attached documents printed from PAIR for the above-referenced application. Pending claims 47-60 correspond directly to one of the restricted groups of the parent application.

It is the applicants current understanding that the form of the preliminary amendment was improper, i.e., preliminary amendments made in a transmittal letter must comply with 37 CFR 1.121. See MPEP 714.01(e). This section of the MPEP, however, goes on to state that the "applicant will be notified by way of a "Notice of Non-Compliant Amendment and given a non-extendable period of one month to bring the amendment into compliance with 37 CFR 1.121." Id.

Applicants have not received such notice. Applicants herewith submit a Preliminary Amendment to correct the prior preliminary amendment's deficiencies. Accordingly, applicants respectfully submit that claims 47-60 are properly pending and request that the Examiner's current Restriction Requirement be withdrawn.

Alternatively, applicants argue that the current Restriction's groupings of XIII, XIV, XV, and XVI, covering claims 47-60, are proper for examination pursuant to the reasons already provided in the applicants' Response to Restriction Requirement filed in the parent application. The prior restriction in the parent application should also estop the Office from further reclassifying the current invention. Applicants choose the species shown in claim 49 for search purposes.

Application No.: 10/649,951

Docket No.: 22227-00003-US2
(PATENT)

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 22227-00003-US-2 from which the undersigned is authorized to draw.

Dated: Aug. 23, 2004

Respectfully submitted,

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